

No. 16154.

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

THE COLEMAN COMPANY, INC., a corporation,

Defendant-Appellant,

vs.

THE SIEGLER CORPORATION, a corporation,

Plaintiff-Appellee.

REPLY BRIEF OF DEFENDANT-APPELLANT THE COLEMAN COMPANY.

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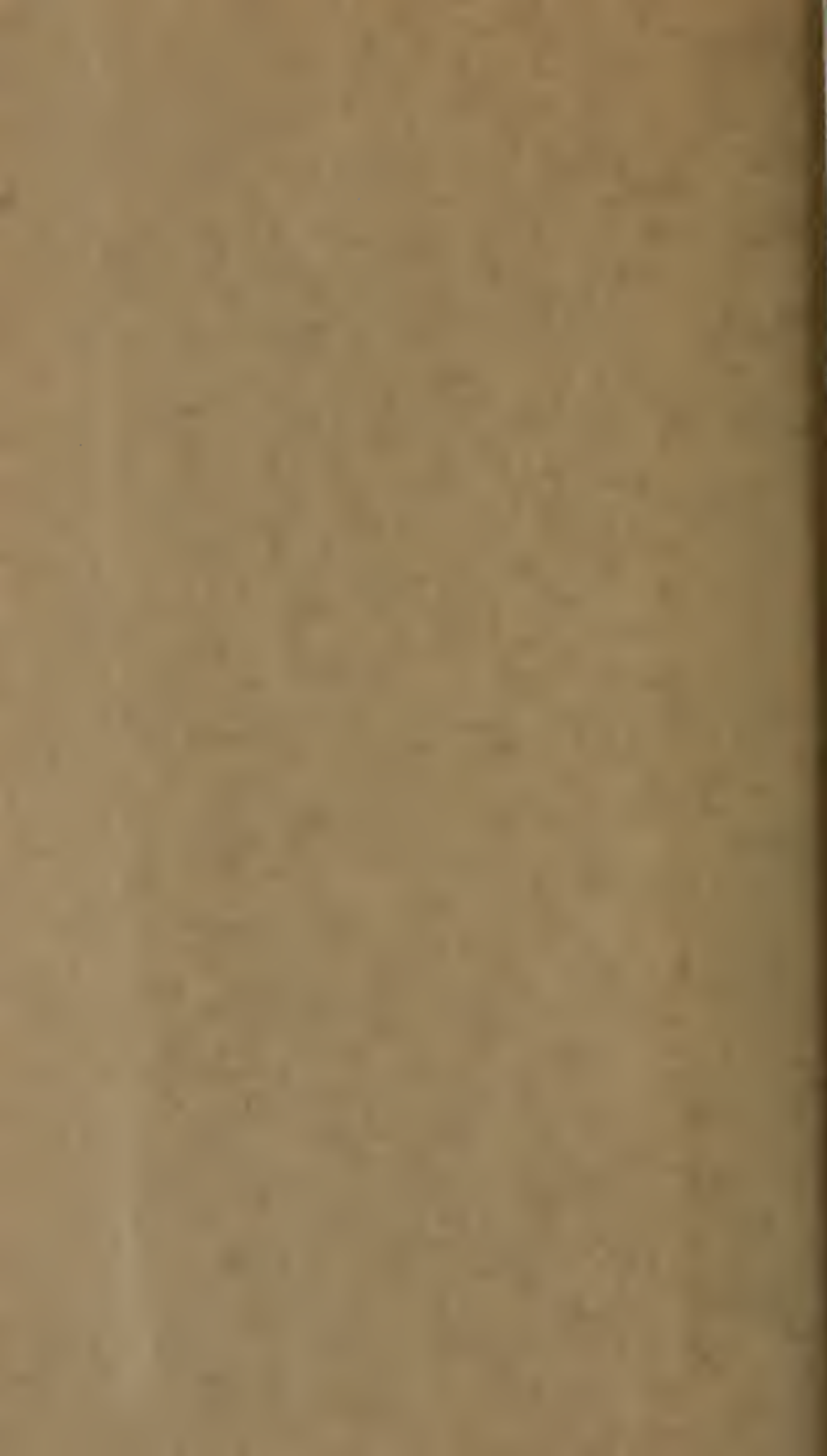
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**REPLY BRIEF OF DEFENDANT-APPELLANT
THE COLEMAN COMPANY.**

Although many of the charges, contentions, and insinuations contained in Siegler's brief relate to matters which are not relevant to the issues presented by this appeal, Coleman has no objection to a full discussion of any aspect of the present case. Coleman will therefore make as complete a reply as possible without unduly extending the length of this brief.

**a. Siegler's Reliance on the Prior Decision in the
Holly Case Is Misplaced.**

Siegler's initial contention appears to be that Judge Mathes' decision in *Coleman Co. v. Holly Mfg. Co.* (which was affirmed by this Court on appeal, 233 F. 2d 71) supports the summary disposition of the present case, even though such disposition might otherwise have been improper. The legal basis for this contention is not stated

by Siegler, and it is clear that there is none. The Giwosky patent had not issued at the time Judge Mathes rendered his decision in the *Holly* case. Consequently, that case could not have involved, either directly or indirectly, the issues of whether the Giwosky patent is valid, or whether it is infringed by the modified heater which Holly first introduced in 1954.

It is well settled that the doctrine of *res judicata* or estoppel by judgment can have no application to issues which were not involved in the prior suit: *Davis v. Brown*, 94 U. S. 423; *Lorber v. Vista Irr. Dist.*, 127 F. 2d 628, 634 (9th Cir., 1942).

The fact that Coleman had applied for and later obtained the Giwosky patent was not relevant to any issue in the *Holly* case prior to the accounting trial therein. The operation of a company under its own patent is no defense to a charge of infringement although it is evidence of the company's good faith: *Corning v. Burden*, 56 U. S. (15 How.) 252, 272; *Creagmile v. John Bean Mfg. Co.*, 32 Fed. Supp. 646, 648-649 (S. D. Cal., 1940).

Siegler is seeking to perpetuate and extend the adjudication in the *Holly* case although it is now known to have been based on erroneous evidence. At the time Judge Mathes held with respect to the Hollingsworth patent that the differences between the Coleman heater and the Holly heater were "immaterial" on the issue of infringement, the court accepted the now discredited Landsberg tests as establishing that the lower wall spaces provided a major source of air for the Coleman economizers. Where the premise upon which a prior adjudication was based is later found to be untrue, the prior adjudication must be completely disregarded in the determination of all issues in a subsequent suit between the same parties: *West*

Coast Life Ins. Co. v. Merced Irr. Dist., 114 F. 2d 654, 661-662 (9th Cir., 1940); *National Popsicle Corp. v. Icy-clair*, 119 F. 2d 799, 800 (9th Cir., 1941).

b. Coleman's Conduct With Respect to the Giwosky Patent Shows the Utmost Good Faith.

With complete disregard for the facts, Siegler accuses Coleman of acting in bad faith with respect to the Giwosky patent. The conduct which Siegler characterizes as "stubbornly litigious" consists of (1) being sued by Siegler, and (2) appealing from a summary invalidation of its Giwosky patent. Obviously, the aggrieved party here is Coleman, not Siegler.

If Coleman had been permitted to have a trial on the issues of validity and infringement, it would have been proven that the design of the Hollingsworth patent was defective, that Giwosky discovered the defect, and that the Giwosky patent represents a better solution to the problem of how to avoid hot walls while obtaining a high efficiency in a gas wall heater. As Giwosky stated in his affidavit that was filed by Coleman in opposition to the motion for summary judgment [R. 87-88]:

"During the design and experimental work leading to the wall heater described in my patent 2,767,702, I first encountered a problem of overheating in the area immediately above the closure plate of the primary heater box. To overcome this problem I provided an opening in the heater just above this closure plate through which cool room air could circulate."

The fact that the Hollingsworth design was defective and that Giwosky had to create a new design is evidenced by a letter written in January of 1953 by Dean Olds, who was the immediate superior of Giwosky at Coleman during

the period when Giwosky developed his design. At the accounting trial in the *Holly* case, Olds testified as a witness for Holly, being no longer connected with Coleman and having served as a consultant for Holly's successor, the plaintiff herein. On cross-examination, Olds admitted the truth of the statements in his letter of January 1953, which included the following:

"At the time of the introduction of the Holly unit which has the upper radiator or heat exchanger, AGA had not tested a device of that type. Apparently after some consultation it was decided that the unit would have to be of both the economizer and the lower unit as a package. Those tests apparently were not carefully conducted, but when we retested the unit under supposedly the same conditions, we found excessive wall temperatures to exist, especially just above the outlet of the second stage warm air discharge noted at 44, fig. 1. Later this was substantiated by retest at AGA.

"I think, then, that this may be the explanation of why we found it necessary to stop the circulation of air from the bottom unit to the top unit, whereas Hollingsworth felt that this air was of advantage to him." [Holly R. 1269.]¹

Having invented what he considered to be a new and advantageous wall heater design, Giwosky applied for his patent *within one year* after Coleman began selling the Giwosky heater, as permitted by the law (35 U. S. C., Sec. 102-b, Append. B.). In the affidavit filed in behalf of Coleman in this case, Giwosky confirmed that there had

¹The citation is to the five-volume record in *Coleman v. Holly*, Appeal No. 16141, which record has been incorporated herein by stipulation.

been no public use or public disclosure of his invention more than one year before the filing date of his patent [R. 88]. Siegler's criticism of the short delay in applying for the Giwosky patent is therefore immaterial as a matter of law.²

c. The Basis for the Asserted Infringement.

At the time the Giwosky application was filed (October 1, 1953), Holly was manufacturing wall heaters exactly as shown in its Hollingsworth patent [R. 80, 87]. However, when Holly was required to submit its heater for retest by AGA in 1954 pursuant to new retroactive requirements [Holly R. 1164-1165], the Hollingsworth design was modified [R. 80]. In making the 1954 modification (which provides the basis for Coleman's charge of infringement herein), Hollingsworth had full knowledge of the Giwosky design, the Coleman heaters incorporating this design having been on the market all during 1953 [R. 80].

In the present case Coleman is not complaining about a mere unintentional air "leakage". The new opening which Holly provided in its modified heaters of 1954 is located in exactly the same position as the direct room air inlet of the Giwosky design, and the passage extending between

²It is also immaterial that Claim 2 of the Giwosky patent was not presented in its final wording until shortly before the allowance of the patent. This claim was not directed to new subject matter. Claim 3 of the original application covered the same air inlet arrangement (Giwosky file wrapper, p. 7). In the negotiations between an applicant and the Patent Office, the applicant is permitted to amend his claims or to present rewritten claims for the purpose of more accurately defining the inventive subject matter: *Glade v. Walgreen Co.*, 122 F. 2d 306, 311 (7th Cir., 1941); *Coats Loaders & Stackers, Inc. v. Henderson*, 233 F. 2d 915, 924 (6th Cir., 1956); *Carson v. American Smelting & Refining Co.*, 4 F. 2d 463, 470-471 (9th Cir., 1925).

this opening and Holly's economizer inlet is of such a size that both hands can be inserted therein. [See opening marked "O" in Exhibit A attached to the Newton affidavit, R. 85, 80.]

As stated in the Newton affidavit filed by Coleman herein [R. 80]:

"In 1954 the Holly Manufacturing Company introduced a new line of gas wall heaters, which in my opinion included a feature that to my knowledge had previously been offered commercially only on the line of wall heaters which the Coleman Company began selling late in 1952. Holly had a line of wall heaters on the market during the years 1952 and 1953, but the wall heaters that it was selling in those years did not provide a room air inlet on the front of the heater immediately above the closure plate for the lower box. The line of heaters which Holly introduced in 1954, however, did provide such an opening."

To facilitate a comparison between the original Hollingsworth design and the Giwosky design, the principal figure from the drawings of each patent is reproduced in Appendix A hereto, and explanatory legends concerning the air flows have been added to the figures. As pointed out on these exhibits, the Hollingsworth design as shown in his patent is completely devoid of any kind of air inlet for supplying room air directly to the economizer. It necessarily follows that the specific air inlet arrangement of Claim 2 cannot be derived from anything found in the Hollingsworth patent.

The situation is quite different with respect to Holly's modified design of 1954 [R. 85, 80], as well as with respect to the wall heaters presently manufactured and sold by Siegler, which were introduced in 1957 [R. 86, 81].

These wall heaters do have an air inlet arranged in the manner described in the Giwosky patent. It is evident, therefore, that the present suit involves a substantial issue of infringement.³

d. The Contention That Coleman Never Used the Giwosky Design Is Easily Refuted.

It has never heretofore been seriously disputed that the Coleman economizers at least partially utilized the air inlet means of the Giwosky patent. In fact, even the erroneous Landsberg data indicated that most of the air in Coleman's economizers was admitted directly from the room [Holly Orig. R. 226-227].⁴ Actually, as the evidence in the *Holly* case now conclusively demonstrates, the only wall space or so-called "pink" air reaching the economizers in the Coleman heaters was mere incidental leakage which had no useful or beneficial effect [Holly R. 1592-1594, 1749-1751, 1504-1515, 1579-1581].

Nevertheless, Siegler contends in its brief that the design used by Coleman was not in fact the Giwosky design because such leakage did occur. Siegler (Br. 3, 51-52) refers to letters written by Mr. Dawson which are said to represent that the Giwosky design did not involve supplying the economizers with the so-called "pink" air. However, in these letters Mr. Dawson was not excluding the possibility of an incidental leakage of pink air, as indi-

³If the Giwosky patent has merely a "nuisance value", it is strange indeed that Siegler filed this suit for declaratory judgment only two days after it replied to Coleman's notice of infringement [R. 6, 131]. In this connection it may also be noted that prior to the bringing of its motion for summary judgment, Siegler took extensive depositions in the case at bar. Such actions are obviously inconsistent with Siegler's claim that it regards the Giwosky patent as of no significance.

⁴The reference is to the original three-volume record in *Coleman v. Holly*, also incorporated herein by stipulation.

cated in the last paragraph of one of the letters [R. 155-156]. This interpretation is also in accordance with Mr. Dawson's testimony at the accounting trial in the *Holly* case [Holly R. 789]:

“Q. (By Mr. Stanbury): Now, when you wrote this letter [Pl. Ex. 12, R. 154-156] you evidently had in mind the possibility of some leakage from around the lower box into the economizer, is that correct? A. That is correct.”

The heater shown in the drawings of the Giwosky patent does in fact correspond exactly with Coleman's commercial heater [R. 314, Holly Accounting Ex. AA].⁵ Even the space through which the pink air leaked into the economizer can be seen in Figure 2 of the Giwosky patent [R. 314; also see reproduction of Fig. 2 in Append. A and explanatory legends thereon.]

e. Siegler's Generalized Treatment of the Subject Matter of Claim 2 Is Prohibited by Law.

In its brief (7-8) Siegler quotes Claim 2 of the Giwosky patent, but thereafter makes no attempt to apply the specific limitations of this claim to the prior art. Instead, Siegler seeks to generalize the subject matter of Claim 2 for the purpose of providing itself with a target which may be attacked on a somewhat more plausible basis. This is prohibited by the well established rule that it is the precise language of the *claim* which defines the dis-

⁵The fact that Coleman did not mark the Giwosky patent number on its wall heaters has no bearing on the matter. Such marking was impossible prior to the issuance of the patent on October 23, 1956. Thereafter, as an alternate to marking, a notice of infringement was sent to Siegler, the only known infringer, within a few weeks after the issuance of the patent [R. 131]. This is in accordance with the statutory provision which eliminates the marking requirement in establishing a right to damages where actual notice is given (35 U. S. C., Sec. 287, Append. B).

tinctive features of the invention in relation to the prior art: *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 277; *Mojonnier Dawson Co. v. U. S. Dairy Sales Corp.*, 251 F. 2d 345, 351 (7th Cir., 1958).

The difference between the Hollingsworth design and the Giwosky design as defined in Claim 2 does not lie merely in the provision of an inlet for supplying the economizer with room air, although this difference was the one which was especially relevant in relation to the infringement issue in the *Holly* case. As discussed at considerable length in Coleman's opening brief (6, 8-9, 20-26), Claim 2 is directed to specific features of the Giwosky design combination which are not found in the prior art. In the arrangement specified in Claim 2, the room air, before being introduced into the bottom of the economizer, passes over the upper surface of a "barrier plate" in "heat exchange relation therewith."⁶ As further brought out in the claim, this "barrier plate" forms the top of the lower or primary heater, and the "heated air outlet" for the lower heater is "adjacent the underside" of the barrier plate. This construction, which is not found in the Hollingsworth patent or any of the other prior art patents,⁷ permits the extremely hot air from within the primary heater to be discharged to the room at a point immediately beneath the lower end of the room wall without raising the temperature of the room wall to an objectionably high level (see Giwosky File Wrapper, p. 54).

⁶Siegler's denial (Br. 22-26) that this phrase requires elucidation by expert testimony is not convincing because it was Siegler that raised the question below as to the meaning of the phrase (Op. Br. 26-28).

⁷At the very least this is clearly a triable issue which should not have been resolved against Coleman's patent on a motion for summary judgment.

In its examination of the Giwosky application, the Patent Office was well aware that it was not broadly new to supply room air to an economizer. The Bacon and Derrough patents [R. 343-346, 341-342], which were officially cited against the Giwosky application, establish this fact. These patents also demonstrate that Claim 2 could not cover *merely* what Siegler chooses to say it covers, else it would not have been allowed in the first place (Op. Br. 18-19).

As demonstrated in Coleman's opening brief (9, 19, 22-24), the Browell patent is at most only cumulative of the Bacon and Derrough patents, and cannot therefore be regarded as having any special status on a motion for summary judgment. Siegler, however, instead of meeting the issue squarely has attempted to rely on certain statements which were made by representatives of Coleman at the original trial in the *Holly* case.

The quoted statements are to the effect that the principle of supplying room air directly to an economizer is shown in the Browell patent. This is true. However, the specific arrangement defined in Claim 2 was not under consideration when the statements were made. As to the relative pertinence or non-pertinence of the Browell patent, it can be pointed out that throughout the appeal in the prior suit, Holly emphatically denied that Browell had any particular relevance to the Coleman heaters. For example, on page 33 of its brief to this court in the prior case, Holly stated:

"A study of the Browell patent, moreover, shows that what it discloses *is basically* [*sic*] different from what defendant makes himself. All that Browell discloses is a jacketed pipe connected to a fireplace.
* * * In short, the Browell fireplace and jacketed flue bear no more than a superficial resemblance to defendant's wall heaters."

The Trial Court's Findings of Fact in This Case Obviously Cover Disputed Issues.

The lower court entered twenty-three Findings of Fact [R. 130-135]. Eleven of these, Findings 12 through 22, unmistakably involve disputed issues of fact. These fact questions all relate to the primary issue of whether the Giwosky patent is valid over the prior art, or more specifically, whether the subject matter of Claim 2 is anticipated by the Browell patent and the Hollingsworth patent. Since Coleman's Statement of Genuine Issues designated the foregoing issues as involving genuine, material, and triable questions of fact [R. 92, Issues 14, 16, 17], it was clear error for the trial court to decide them on motion for summary judgment: *Bridgeport Brass Co. v. The Bostwick Laboratories*, 181 F. 2d 315, 316 (2d Cir., 1950); *Glenn v. Southern California Edison Co.*, 187 F. 2d 318, 321 (9th Cir., 1951).

In dismissing the presumption of validity attaching to the Giwosky patent as being of no significance, the trial court assumed (although the question was plainly disputed and triable) that the Browell patent was more pertinent to the subject matter of Claim 2 than the patents cited by the Patent Office (Op. Br. 13-18). The lower court took this action notwithstanding the fact that Coleman's Statement of Genuine Issues squarely called into question the factual basis of this assumption [R. 92-93, Issues 18 and 19]. Here again the trial court committed unmistakable error in deciding disputed issues of fact on a motion for summary judgment.

Siegler's attempt (Br. 13-20) to dismiss the findings herein as "a handy summary" merely serves to call attention to the gross departure of the lower court from the established rule governing the granting of summary judg-

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Siegler's attempt (Br. 13-20) to dismiss the findings herein as "a handy summary" merely serves to call attention to the gross departure of the lower court from the established rule governing the granting of summary judg-

ments. Of course, the findings herein summarize facts, but the controlling consideration is that they summarize *disputed* facts and form part, at least, of the court's basis for entering summary judgment.

Siegler (Br. 13) cites the recent decision of this Court in *Trowler v. Phillips*, 260 F. 2d 924. However, that case is clearly unfavorable to Siegler's position on this appeal. As pointed out in the *Trowler* case, "all too often a set of unnecessary findings of fact is the telltale flag that points the way to a discovery that summary judgment should not have been granted." The error in the present case is even more evident than it was in the *Trowler* case. The findings entered herein were prepared by Siegler's counsel, and if all of them were not considered necessary to support the judgment, why then were they presented and entered?

g. Siegler Confounds the Distinction Between Issues of Law and Issues of Fact.

It is true, as indicated in Siegler's brief (21-22), that the question of validity of a patent is ultimately a question of law. However, it is equally evident that before the proper legal standard can be applied, the facts must first be found. The issue of patent validity necessarily involves the determination of fact questions, which once resolved may well be completely binding on a reviewing court. (See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U. S. 271, 275.)

Siegler does admit (Br. 22) that "the nature of the prior art and what the patentee did to improve upon it . . . are questions of fact." Siegler goes on to say, however, that these matters "are not genuine issues for dispute", apparently because the trial court as well as this

Court are assumed to already know the answers, having had an opportunity to become familiar with some of the subject matter in connection with the prior *Holly* case. Siegler fails to point out, however, where in the prior suit the specific fact issues here involved became relevant and were decided. They never were. Obviously, Coleman has had no opportunity to introduce evidence on the following questions, which among others first became material in connection with the *present* suit:

- (1) Does the specific air inlet arrangement covered by Claim 2 of the Giwosky patent differ patentably from the disclosure of the Browell patent?
- (2) Would the Browell patent suggest to a man skilled in the gas wall heater art that the design of the Hollingsworth patent should be modified in the manner taught by Giwosky and covered by Claim 2 of his patent?
- (3) Can any elements and structural relationships defined in Claim 2 which fail to correspond with anything disclosed by Browell or Hollingsworth be dismissed as immaterial?
- (4) Can the air inlet arrangement of Claim 2 be considered to have been obvious to a man of ordinary skill in the wall heater art, or to be lacking in patentable novelty, when the closest prior art patent (Hollingsworth) teaches that the economizer should be supplied entirely with air from the lower wall spaces?
- (5) Does the specific combination of Claim 2 produce any result not produced in the prior art, or any unexpected result?
- (6) Exactly where in the prior art, if at all, can there be found the elements and structural relationships defined in Claim 2?

- (7) Do the elements of the Giwosky combination, insofar as present in the prior art, perform any additional or different functions in the Giwosky combination than they performed in the prior art?

The lower court's findings [R. 132-135] clearly could not have been entered without a determination of each of the above disputed and triable questions of fact. This represents fundamental error on a motion for summary judgment.

Conclusion.

The decision below that this suit contains no issue worthy of trial is clearly erroneous. Therefore, this Court is respectfully requested to remand the case for a full hearing on the validity and infringement issues.

Respectfully submitted,

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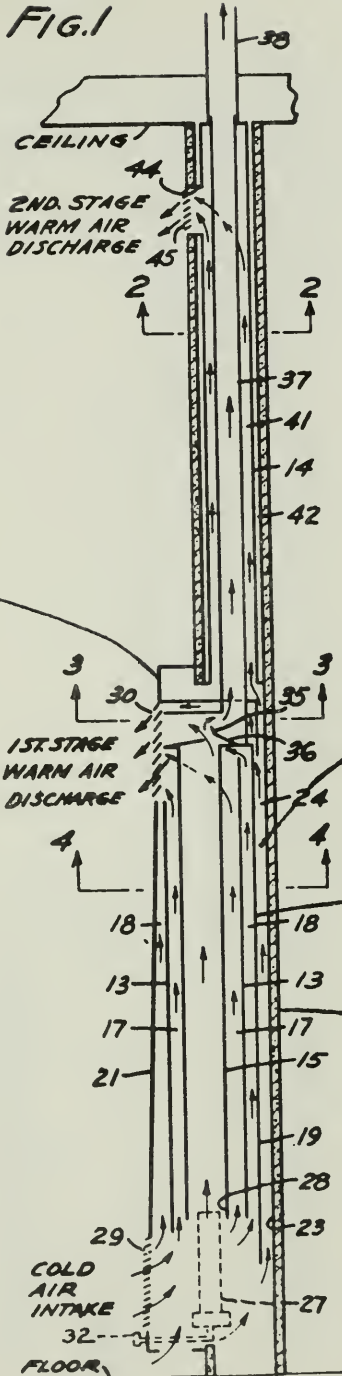
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APPENDIX A.



FIG. 1

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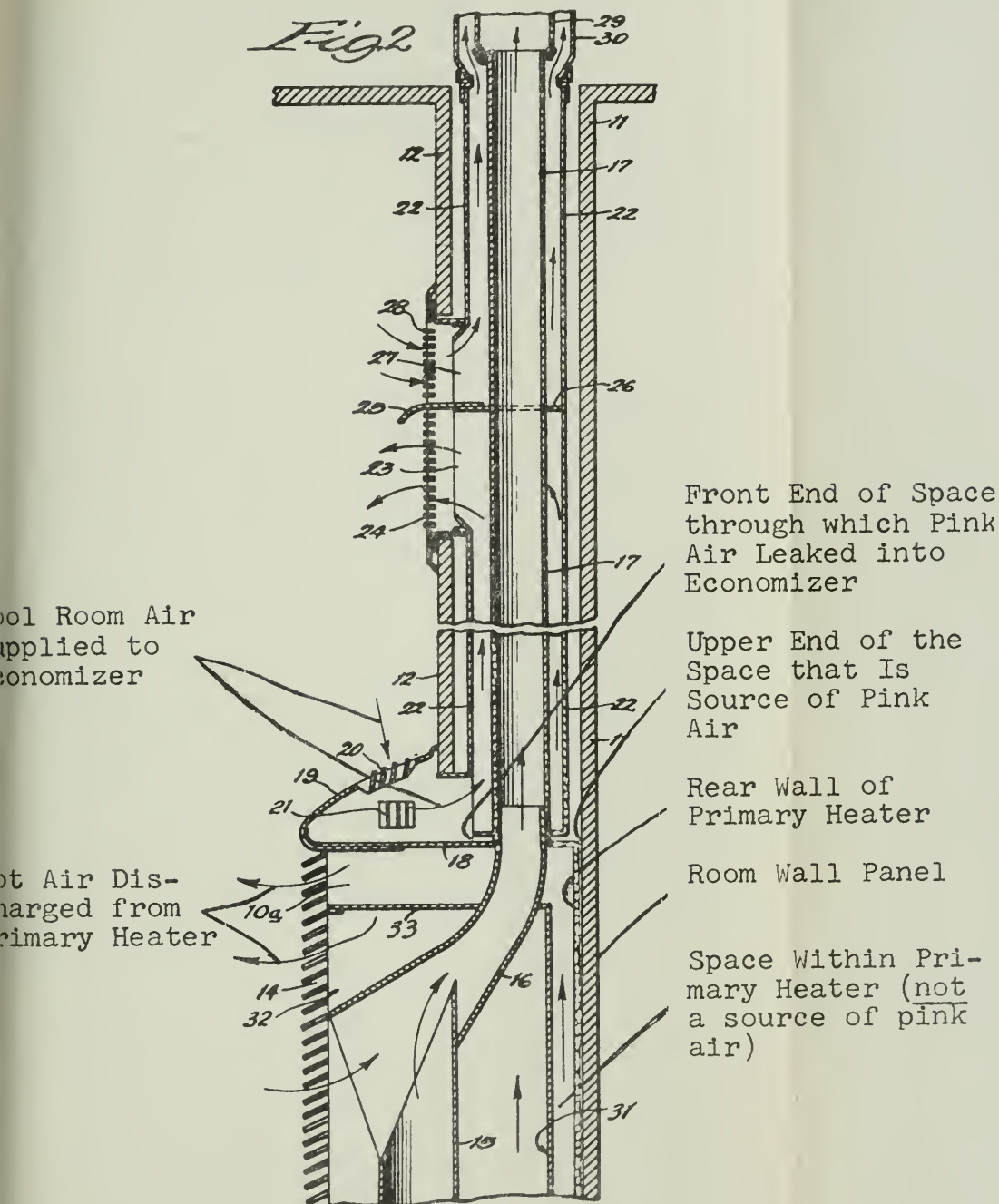


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FIGURE 2 FROM GIWOSKY
PATENT WITH EXPLANATORY
LEGENDS RE AIR FLOWS





APPENDIX B.

35 U. S. C., Sec. 102(b).

“A person shall be entitled to a patent unless—

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, *more than one year* prior to the date of the application for the patent in the United States,” (Emphasis added.)

35 U. S. C., Sec. 287.

“Patentees, and persons making or selling any patented article for or under them, *may* give notice to the public that the same is patented, either by fixing thereon the word ‘patent’ or the abbreviation ‘pat.’, together with the number of the patent, or when, from the character of the article, this can not be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement, *except on proof that the infringer was notified of the infringement* and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice. Filing of an action for infringement shall constitute such notice.” (Emphasis added.)

